

REMARKS

Claims 1-92 remain pending and under current examination. Claims 1, 29, 36, 43, 74, 78, 87, and 91 have been amended to correct minor errors.

In the Office Action dated August 24, 2006, the Examiner rejected claims 1-4, 6-8, 10-11, 29-35, 43-46, 48-50, 52-53, 71-77, 85, 87, 89, and 91 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6, 282,658 to French et al. ("French"), and rejected claims 5, 9, 12-15, 16-20, 23-38, 36-39, 51, 54-62, 65-70, 78-79, 80-81, 86, 88, 90, and 92 under 35 U.S.C. § 103(a) as being unpatentable in view of French. The Examiner also rejected claims 21-22, 40-42, 63-64, and 82-84 as being unpatentable over French in view of U.S. Patent No. 6,745,327 to Messing ("Messing"). As in the December 1, 2005 Office Action, claim 47 does not appear to be listed in the text of the Office Action, but claims 1-92 are all listed as rejected in the summary of the Office Action. Because claim 47 contains recitations similar to claim 5, Applicants assume that the Examiner meant to reject claim 47 under 35 U.S.C. § 103(a) as being unpatentable in view of French.

Rejections under 35 U.S.C. § 102(e)

Applicants respectfully traverse the rejection of claims 1-4, 6-8, 10-11, 29-35, 43-46, 48-50, 52-53, 71-77, 85, 87, 89, and 91 as being anticipated by French. French does not teach each and every element recited in any of claims 1-4, 6-8, 10-11, 29-35, 43-46, 48-50, 52-53, 71-77, 85, 87, 89, and 91 as required to support a proper rejection under 35 U.S.C. § 102(e). See M.P.E.P. § 2131 (8th ed. 2001, 3rd revision August 2005).

French, for example, fails to teach “sending an identification verification form to a physical address of the user,” and then “*verifying* the identity of the user in person using the identification verification form *at the proofing workstation*” (emphasis added).

Instead, as the Examiner noted, French teaches “an offline remote authentication embodiment of the invention, in which some processing including delivery of a *validated* ID is conducted using ordinary mail.” French, col. 19, ll. 32-35 (emphasis added).

Thus, French teaches delivery of a *validated* ID, not sending an identification verification form to a physical address of the user prior to validation and verifying the identity of the user in person using the identification verification form at the proofing workstation.

Moreover, Fig. 42 of French illustrates “an offline authentication state 1010, in which *verification* is transmitted using regular mail.” See French, col. 19, l. 55-col. 20, l. 11 (emphasis added). As shown in Fig. 42, mailability filter 1012 can either send a PIN at mail state 1014 or enter failure state 1016, thereby indicating that a verification decision is already made at the time of mail state 1014 in French. See French, Fig. 42, col. 20, ll. 5-11 (“If a sufficient score is reached in the mailability filter 1012 processing, a mail state 1014 is reached in which the entered addressing information is used to transmit a PIN or other identification information to the user via regular mail. If a sufficient score is not reached in the mailability filter 1012, a failure state 1016 is reached, no verification is sent by mail and processing terminates.”)

Further, the Examiner’s references to col. 8, ll. 50-55, col. 10, ll. 28-36, or col. 11, ll. 17-26 of French do not teach “verifying the identity of the user in person using the identification verification form at the proofing workstation.” Specifically, French discloses “checks may be executed against a credit card database . . . may include

ensuring that the available credit line is sufficient to make the purchase, ensuring that the billing address for the credit card in the database matches the submitted address, and ensuring that the credit card is not stolen" (col. 11, ll. 19-25), "validation checks including standard field checks, social security number validation, address validation, area code validation, and driver's license validation and other preliminary data verification" (col. 8, ll. 51-55), and "[r]esponses, or actions, for each of the possible address-related status codes . . . provided as output" (col. 10, ll. 28-36). However, such disclosures do not constitute a teaching of "verifying the identity of the user in person using the identification verification form at the proofing workstation," as recited in claim 1.

French also fails to teach "receiving the identification verification form from the user in person at a proofing workstation," as recited in claim 1. As the Examiner noted, French discloses

First, standard field checks preferably occur at client 110, where and when the requested data is collected, to ensure that all required data is present and all provided data is in the proper format and meets minimum requirements. Completing this processing at client 110 minimizes the number of requests that must be terminated at this early point in the authentication process due to formally incorrect data. This is particularly important when the user is not present at the time of authentication, such as when requests are submitted in batch form rather than interactively. In general, the standard field checks make sure that an expected range or format of characters are input by the user, appropriate to individual queries and data types.

French, col. 8, l. 61 - col. 9, l. 6. However, French further discloses that "client 110 communicates with application server 130 over a physical or wireless transmission link 150." See French, col. 5, ll. 33-42. French therefore does not disclose "receiving

the identification verification form from the user *in person* at a proofing workstation,” as recited in claim 1.

Because French does not disclose every element of claim 1, French cannot anticipate the claim, and Applicants request the reconsideration and withdrawal of the § 102(e) rejection of claim 1. Independent claims 29, 43, 71, 85, 87, 89, and 91, although different in scope from claim 1, recite similar elements, and are therefore allowable for at least the same reasons. Applicants thus request withdrawal of the § 102(e) rejection and the timely allowance of claims 1, 29, 43, 71, 85, 87, 89, and 91, as well as their dependent claims.

Rejections under 35 U.S.C. § 103(a)

Applicants also traverse the rejection of claims 5, 9, 12-15, 16-20, 21-22, 23-38, 36-39, 40-42, 47, 51, 54-62, 63-64, 65-70, 78-79, 80-81, 82-84, 86, 88, 90, and 92 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established based on French or based on French in view of Messing. As M.P.E.P. § 2142 states, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and

not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001). Here, no *prima facie* case of obviousness has been established for at least the reason that French fails to teach or suggest each and every element of claim 1.

As discussed above, French does not teach "sending an identification verification form to a physical address of the user," "verifying the identity of the user in person using the identification verification form at the proofing workstation," and "receiving the identification verification form from the user in person at a proofing workstation."

Messing does not cure French's deficiencies. Messing discloses a program for using user-supplied data such as a photograph, a public key, a retinal scan, fingerprints, or a handwriting sample to create an electronic certificate signature. Messing, Fig. 1, col. 6, ll. 1-14. Although Messing states "[p]ersonal information (FIG. 1, no.12), is verified in person by an agent," (Messing, col. 6, ll. 1-4), the reference does not teach or suggest the steps of "sending an identification verification form to a physical address of the user" and "receiving the identification verification form from the user in person at a proofing workstation," as recited in claim 1. Further, Messing does not teach or suggest "verifying the identity of the user in person using the identification verification form at the proofing workstation," as also recited in claim 1.

For at least the reason that the cited references fail to teach each and every element of claim 1, no *prima facie* obviousness has been established and the § 103(a) rejection of claims 5, 9, and 12-15, which depend from independent claim 1, should be withdrawn. Independent claims 16, 36, 58, 78, 86, 88, 90, and 92, although different in scope from claim 1, recite similar elements, and are therefore allowable for at least the same reasons. Independent claim 43 is also different in scope from claim 1, but recites

similar elements, and therefore its dependent claims 51 and 54-57 are allowable for at least the same reasons.

Applicants thus request withdrawal of the § 103(a) rejection and the timely allowance of claims 5, 9, 12-15, 16-20, 21-22, 23-38, 36-39, 40-42, 47, 51, 54-62, 63-64, 65-70, 78-79, 80-81, 82-84, 86, 88, 90, and 92.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request continued examination of this application and the timely allowance of pending claims 1-92.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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